

MAR 26 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: George Bradley Hobbs

Examiner: Jean D. Janvier

Serial No.: 09/734,290

Group Art Unit: 3622

Filed: December 11, 2000

Docket No.: 10003973-1

Title: PRINT PROCESSING SYSTEM AND METHOD WITH INTERFACE
ADVERTISING**CERTIFICATE OF TRANSMISSION**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that the following papers are being facsimile transmitted to the U.S.
Patent and Trademark Office, Fax No.: (571) 273-8300 on the date shown below:

1. Transmittal Letter for Reply Brief (1 pg.); and
2. Reply Brief to Examiner's Answer (7 pgs.)

Respectfully submitted,

George Bradley Hobbs,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2006
Facsimile: (612) 573-2005Date: MAR. 26, 2007
SAL:hsfBy: Scott A. Lund
Reg. No. 41,166**9 PAGES - INCLUDING COVER PAGE**

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATIONATTORNEY DOCKET NO. 10003973-1**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**Inventor(s): **George Bradley Hobbs**Confirmation No.: **3711**Application No.: **09/734,290**Examiner: **Jean D. Janvier**Filing Date: **December 11, 2000**Group Art Unit: **3822**Title: **PRINT PROCESSING SYSTEM AND METHOD WITH INTERFACE ADVERTISING**

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEFTransmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on January 26, 2007.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Typed Name: **Scott A. Lund**Signature: 

Respectfully submitted,

George Bradley Hobbs

By **Scott A. Lund**

Attorney/Agent for Applicant(s)

Reg No. : **41,168**Date : **March 26, 2007**Telephone : **612.573.2006**

Rev 10/06 (Reply Brief)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	George Bradley Hobbs	Examiner:	Jean D. Janvier
Serial No.:	09/734,290	Group Art Unit:	3622
Filed:	December 11, 2000	Docket No.:	10003973-1
Title:	PRINT PROCESSING SYSTEM AND METHOD WITH INTERFACE ADVERTISING		

REPLY BRIEF TO EXAMINER'S ANSWER

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

This Reply Brief is presented in response to the Examiner's Answer mailed January 26, 2007, and in support of the Notice of Appeal filed August 18, 2006 and the Appeal Brief filed November 1, 2006, appealing the rejection of claims 1-26 and 29-34 of the above-identified application as set forth in the Office Action mailed May 18, 2006.

At any time during the pendency of this application, please charge any fees required or credit any overpayment due to Deposit Account No. 08-2025 pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees required to Deposit Account No. 08-2025 under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Appellant respectfully requests reconsideration and reversal of the Examiner's rejection of pending claims 1-26 and 29-34.

Reply Brief to Examiner's Answer

Appellant: George Bradley Hobbs

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Title: **PRINT PROCESSING SYSTEM AND METHOD WITH INTERFACE ADVERTISING****ARGUMENT****Reply to Examiner's Response to Argument**

Regarding the rejection of claims 1-26 and 29-34 under 35 U.S.C. 103(a) as being unpatentable over Dutta US Patent No. 6,891,635, Appellant notes that independent claim 1 includes "communicating an interface of the customer with the print processing system controller via the network communication link" and "presenting the advertisement to the customer via the network communication link when the print processing system controller processes the job ticket for the print job," wherein presenting the advertisement to the customer includes "displaying the advertisement on the interface of the customer," independent claim 11 includes "communicating an interface of the customer with the print processing system controller via the network communication link and transmitting a job ticket for the print job to the print processing system controller via the interface" and "presenting the at least one of the advertisements to the customer via the network communication link," wherein presenting the at least one of the advertisements to the customer includes "displaying the at least one of the advertisements on the interface of the customer," and independent claim 21 includes "a customer interface configured to communicate with the print processing system controller to transmit a job ticket for the print job to the print processing system controller," wherein the print processing system controller is adapted to "process the job ticket for the print job and display the advertisement on the customer interface when processing the job ticket." Independent claims 1, 11, and 21, therefore, each include displaying the advertisement on the customer interface.

The Examiner asserts that with the method and system of the Dutta patent:

...targeted advertisements can be presented or displayed to the user, over the network, when the print processing system or the web server processes a print job or print a request for printing submitted by the user (Examiner's Answer, sect. 10, p. 10).

However, the Examiner goes on to affirm that:

Dutta...does not expressly disclose displaying the advertisement on the customer's interface (computer screen or display), while receiving or

Reply Brief to Examiner's Answer

Appellant: George Bradley Hobbs

Serial No.: 09/734,290

Filed: December 11, 2000

Docket No.: 10003973-1

Title: PRINT PROCESSING SYSTEM AND METHOD WITH INTERFACE ADVERTISING

processing the print job, instead of printing the advertisement together with the customer's document (Examiner's Answer, sect. 10, p. 10).

Thus, while Appellant agrees with the affirmation of the Examiner that the Dutta patent does not disclose displaying the advertisement on the customer's interface, Appellant respectfully disagrees with the assertion of the Examiner that with the method and system of the Dutta patent targeted advertisements are presented or displayed to the user.

Rather, as recognized by the Examiner, for example, in the Examiner's Answer at section 9, page 4, the method and system of the Dutta patent deals with providing advertisements in web-based printing and, more particularly, deals with providing free or subsidized printing in exchange for advertising space on printed documents (see Dutta, col. 1, lines 9-13). As such, also as recognized by the Examiner, for example, in the Examiner's Answer at section 9, page 4, the Dutta patent discloses a system where advertisements can be placed on printouts requested by users of remote printers such that when the user requests to print out electronic documents, the selected advertisements are included in the printout (see Dutta, col. 2, lines 7-17).

As the Dutta patent does not disclose displaying the advertisement on the customer interface, the Examiner relies on "Official Notice" to suggest the following:

Thus, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure ("Official Notice") into the advertising distribution and printing system of Dutta so as to display a (targeted) advertisement on the screen of a computer's user upon receiving or while processing the user's print job instead of printing the advertisement along with the user's document associated with the print job... (Examiner's Answer, sect. 10, p. 8)

In this regard, the Examiner goes on to suggest the following scenario:

[T]he user in the Dutta's system is patiently waiting for his print job to be completed and is not browsing or switching from one page to another or visiting a new web site. The waiting period creates an idle time or time delay, which provides an excellent opportunity for displaying a message or an ad to the user on the user's interface or computer screen during the waiting period or period of non-activity while the user is patiently waiting for his print job to be completed, as an ordinary skilled artisan would have concluded at the time of the invention. The waiting period, the delay or the idle time, during which a message or an ad is displayed on the user's computer screen, varies from print

Reply Brief to Examiner's Answer

Appellant: George Bradley Hobbs

Serial No.: 09/734,290

Filed: December 11, 2000

Docket No.: 10003973-1

Title: PRINT PROCESSING SYSTEM AND METHOD WITH INTERFACE ADVERTISING

job to print job and it is also based on whether the print job or the document being printed is a text or an image or a combination thereof. And the delay period or the idle time may be greater than, for instance, 60 seconds depending on the number of pages being printed or whether or not the print job includes images or graphics (Examiner's Answer, sect. 10, p. 12).

Although insightful, Appellant respectfully submits, however, that the Dutta patent does not disclose the above scenario suggested by the Examiner. Rather, as outlined above, and as recognized by the Examiner, the method and system of the Dutta patent deals with providing advertisements in web-based printing and, more particularly, deals with providing free or subsidized printing in exchange for advertising space on printed documents (see Dutta, col. 1, lines 9-13).

Regarding the Dutta patent teaching away from displaying advertisements, the Dutta patent recognizes that:

A challenge with Internet based advertisements is that they only appear for a brief time to the user. Often when the user changes screens or visits another web page, they forget the information. If the user did not write the information down or store the advertiser information as a bookmark, they may not be able to remember how to contact the provider of the advertised goods or services (Dutta, col. 1, lines 60-67).

Thus, in this regard, the Examiner recognizes that:

...current web-based advertisements are ineffective since they only appear for a brief time to a user while the user changes screens or visits another web page and the user may forget the information displayed thereon (Examiner's Answer, sect. 10, p. 12).

As such, the Examiner goes on to affirm that, as asserted by the Dutta patent at col. 2, lines 1-3, what is needed is "a way to merge advertisers' objectives of identifying and targeting groups of users with users' need for printing documents while traveling."

Thus, as recognized by the Examiner, merging advertisers' objectives with users' need for printing documents is the objective of the Dutta patent. Accordingly, the Dutta patent discovered a way to merge advertisers' objectives with users' need for printing documents. In this regard, the Dutta patent discloses that "advertisements can be placed on printouts requested by users of remote printers" whereby "[t]he user requests to print out electronic

Reply Brief to Examiner's Answer

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Serial No.: 09/734,290

Filed: December 11, 2000

Docket No.: 10003973-1

Title: PRINT PROCESSING SYSTEM AND METHOD WITH INTERFACE ADVERTISING

documents and the selected advertisements are included in the printout" (emphasis added) (Dutta, col. 2, lines 7-17).

Therefore, by placing the advertisements on the printouts, the Dutta patent has found a way to merge advertisers' objectives with users' need for printing documents, while providing an alternative to display-based advertisements. Modifying the Dutta patent in the manner suggested by the Examiner to display the advertisement instead of place the advertisements on the printout, therefore, would simply return the method and system of the Dutta patent to the arrangement of the stated problem and result in the actual situation that the Dutta patent is trying to overcome. Accordingly, Appellant submits that there is no suggestion or motivation to make the proposed modification.

Regarding the modification suggested by the Examiner rendering the Dutta patent unsatisfactory for its intended purpose, the Examiner suggests that:

...modifying the Dutta's Patent, as suggested here, does not render the Dutta's system unsatisfactory or inoperable since the system will continue to process and execute a requested print job in the same manner except that the associated advertisements are being re-routed and displayed on the user's interface instead of printing them onto the user's printed documents (Examiner's Answer, sect. 10, p. 14).

Appellant submits, however, that having the advertisements "re-routed and displayed" on a user interface is contrary to the teaching of the Dutta patent which provides that the advertisements are included in the printout. Thus, "re-rout[ing] and display[ing]" the advertisements on a user interface would defeat the intended purpose of the Dutta patent. Accordingly, Appellant submits that there is no suggestion or motivation to make the proposed modification.

Finally, regarding the suggested modification of the Dutta patent, the Examiner contends that:

...the combination does yield to a reasonable expectation of success since the chance that the user will pay attention to the ads, displayed on the user's interface during the period of non-activity while the user is patiently waiting for his print job to be completed, significantly increases (Examiner's Answer, sect. 10, p. 14).

Reply Brief to Examiner's Answer

Appellant: George Bradley Hobbs

Serial No.: 09/734,290

Filed: December 11, 2000

Docket No.: 10003973-1

Title: PRINT PROCESSING SYSTEM AND METHOD WITH INTERFACE ADVERTISING

Appellant notes, however, that the Dutta patent specifically recognizes the challenge with display-based advertisements in that "they only appear for a brief time to the user" and that "[i]f the user did not write the information down or store the advertiser information as a bookmark, they may not be able to remember how to contact the provider of the advertised goods or services" (col. 1, lines 60-67).

Thus, with the method and system of the Dutta patent, by providing free or subsidized printing in exchange for advertising space on printed documents, advertisers know the user at least has a printout containing the selected advertisement and, therefore, the advertiser information. Simply displaying the advertisement instead of printing the advertisement, however, is contrary to the advertisers' objectives of effective advertising and, therefore, contrary to the intended purpose of the Dutta patent. Appellant, therefore, submits that there is no suggestion or motivation to make the proposed modification.

Accordingly, for the reasons set forth above, as well as the reasons set forth in the Appeal Brief filed November 1, 2006, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claims 1, 11, and 21, and submits that independent claims 1, 11, and 21 are each patentably distinct from the Dutta patent. Furthermore, as dependent claims 2-10 further define patentably distinct claim 1, dependent claims 12-20 further define patentably distinct claim 11, and dependent claims 22-26 and 29-34 further define patentably distinct claim 21, Appellant submits that these dependent claims are also patentably distinct from the Dutta patent. Appellant, therefore, respectfully submits that the rejection of claims 1-26 and 29-34 under 35 U.S.C. §103(a) is not correct and should be withdrawn, and submits that claims 1-26 and 29-34 should be allowed.

Reply Brief to Examiner's Answer

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Serial No.: 09/734,290

Filed: December 11, 2000

Docket No.: 10003973-1

Title: PRINT PROCESSING SYSTEM AND METHOD WITH INTERFACE ADVERTISING**CONCLUSION**

For the above reasons, Appellant respectfully submits that the art of record neither anticipates nor renders obvious the claimed invention. Thus, the claimed invention does patentably distinguish over the art of record. Appellant, therefore, respectfully submits that the above rejections are not correct and should be withdrawn, and respectfully requests that the Examiner be reversed and that all pending claims be allowed.

Any inquiry regarding this Reply Brief should be directed to either Larry D. Baker at Telephone No. (360) 212-0769, Facsimile No. (360) 212-3060 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

IP Administration
Legal Department, M/S 35
HEWLETT-PACKARD COMPANY
P.O. Box 272400
Fort Collins, Colorado 80527-2400

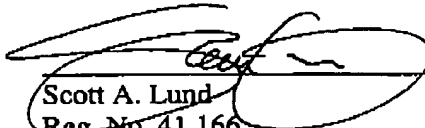
Respectfully submitted,

George Bradley Hobbs,

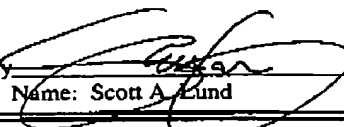
By his attorneys,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2006
Facsimile: (612) 573-2005

Date: Mar. 26, 2007
SAL:hsf


Scott A. Lund
Reg. No. 41,166

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300 on this 26th day of March, 2007.

By 
Name: Scott A. Lund